APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/941,459	09/30/97	MORIKAWA	T 05058/58201

LM31/0313

EXAMINER
POKRZYWA, J

ART UNIT	PAPER NUMBER
2722	17

SIDLEY & AUSTIN
717 NORTH HARWOOD
SUITE 3400
DALLAS TX 75201-6507

DATE MAILED:
03/13/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

☒ Responsive to communication(s) filed on _Dec 20, 1999_   .

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under _Ex parte Quayle_, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire _____3____ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) _4-6, 13-16, and 23-30_ _____ is/are pending in the application.

    Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) _4-6, 13, 23, and 27-30_ _____ is/are rejected.

☒ Claim(s) _14-16 and 24-26_ _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

    ☒ All ☐ Some* ☐None   of the CERTIFIED copies of the priority documents have been

    ☒ received. ˗

    ☐ received in Application No. (Series Code/Serial Number) _____ .

    ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

    *Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Continued Prosecution Application

1.   The request filed on 12/20/99 for a Continued Prosecution Application (CPA) under 37

CFR 1.53(d) based on parent Application No. 08/941,459 is acceptable and a CPA has been

established. An action on the CPA follows.

Response to Amendment

2.   Applicant's amendment received on 11/23/99, and has been entered and made of record.

Currently, **claims 4 through 6, 13 through 16, and 23 through 30** are pending.

Response to Arguments

3.   Applicant's arguments with respect to claims 4 through 6, 13 through 16, and 23 through

30 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United

States before the invention thereof by the applicant for patent, or on an international application by another who

has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention

thereof by the applicant for patent.

5.   **Claims 4, 5, 13, and 28** are rejected under 35 U.S.C. 102(b) as being anticipated by

Oshita (U.S. Patent Number 5,343,306).

Regarding *claim 4,* Oshita discloses an image processing device (facsimile machine,

column 1, lines 46 through 53) operable in a plurality of modes of operation (transmitting or

receiving modes), comprising a memory (page memory 102) for storing image data of a plurality

of frames (column 3, lines 16 and 17, wherein a plurality of frames or pages of documents are

stored in the page memory, see column 8, lines 3 through 17), a controller (line counter 107,

column 3, lines 48 through 51) for determining a state of the image data for each frame (column

5, lines 26 through 33), an operation panel (manual input section 108) for selecting any of the

plurality of modes of operation (column 4, lines 1 through 6), and a controller (controller 10,

column 2, lines 32 through 40) for comparing the state of at least two frames, as determined by

the state decision controller (column 5, lines 26 through 41, wherein the length of at least two

sheets are compared to the currently loaded cut sheet length), and for automatically prohibiting

selecting an inoperable mode (column 5, lines 42 through 49) of operation of the plurality of

modes of operation through the operation panel based on the result of the comparison (column 5,

line 64 through column 6, line 35, column 6, line 64 through column 7, line 20).

Regarding *claim 5*, Oshita discloses the image processing device discussed in claim 4, and

further teaches of the decision controller determines a length of a frame of the image data in a

predetermined direction (column 3, lines 48 through 51).

Regarding *claim 13*, Oshita discloses an image forming apparatus (facsimile machine,

column 1, lines 46 through 53) operable in a plurality of print modes (letter size mode and legal

size mode), comprising a memory (page memory 102) for storing image data of a plurality of

frames (column 3, lines 16 and 17, wherein a plurality of frames or pages of documents are stored

in the page memory, see column 8, lines 3 through 17), a printer (printer 110) for reading the

image data stored in the memory for each frame and for printing (column 3, lines 52 through 68),

a controller (line counter 107, column 3, lines 48 through 51) for determining a state of the image

data stored in the memory (column 5, lines 26 through 33), an operation panel (manual input

section 108) for selecting any of the plurality of print modes (column 4, lines 1 through 6, and

column 6, lines 24 through 40, wherein the START key is pressed after changing paper), and a

controller (controller 10, column 2, lines 32 through 40) for comparing the state of at least two

frames, as determined by the state decision controller (column 5, lines 26 through 41, wherein the

length of at least two sheets are compared to the currently loaded cut sheet length), and for

automatically prohibiting selecting an inoperable print mode (column 5, lines 42 through 49) of

the plurality of print modes through the operation panel based on the result of the comparison

(column 5, line 64 through column 6, line 35, column 6, line 64 through column 7, line 20).

Regarding *claim 28*, Oshita discloses an image processing device (facsimile machine,

column 1, lines 46 through 53) operable in a plurality of modes of operation (transmitting or

receiving modes), comprising a memory (page memory 102) for storing image data of a plurality

of frames (column 3, lines 16 and 17, wherein a plurality of frames or pages of documents are

stored in the page memory, see column 8, lines 3 through 17), a controller (line counter 107,

column 3, lines 48 through 51) for determining a state of the image data for each frame (column

5, lines 26 through 33), a controller (controller 10, column 2, lines 32 through 40) for comparing

the state of at least two frames, as determined by the state decision controller (column 5, lines 26

through 41, wherein the length of at least two sheets are compared to the currently loaded cut

sheet length), and for automatically prohibiting selecting an inoperable mode (column 5, lines 42

through 49) of operation of the plurality of modes of operation through the operation panel based

on the result of the comparison (column 5, line 64 through column 6, line 35, column 6, line 64

through column 7, line 20), and an operation panel (manual input section 108), responsive to the

selection prohibiting controller, for selecting any of the plurality of modes of operation, with the

operation panel automatically prohibiting selecting the thus determined inoperable mode of

operation (column 4, lines 1 through 14, and column 6, lines 7 through 45).

6.   **Claims 4 through 6, 13, and 27 through 30** are rejected under 35 U.S.C. 102(e) as

being anticipated by Yoshida *et al.* (U.S. Patent Number 5,930,006).

Regarding *claim 4*, Yoshida discloses an image processing device operable in a plurality

of modes of operation ("Nin1" operations, such as 2in1 or 4in1, etc., shown in Fig. 24),

comprising a memory (multiport image memory 304 within memory 30, see Fig. 5) for storing

image data of a plurality of frames (column 6, lines 47 through 51, wherein two frames or pages

are stored, and column 7, lines 25 through 28), a controller (CPU 3, column 5, lines 27 through

32) for determining a state of the image data for each frame (column 6, lines 58 through column

7, line 2, and see Fig. 23, column 15, lines 37 through 46), an operation panel (shown in Fig. 7)

for selecting any of the plurality of modes of operation (column 8, line 62 through column 9, line

20), and a controller (CPU3, column 5, lines 27 through 32) for comparing the state of at least

two frames (column 14, lines 19 through 46, and particularly column 16, lines 17 through 55,

wherein the character size of one document is compared to predetermined pixels, and then

repeated for a second document, thus comparing at least two frames), as determined by the state

decision controller (steps S106 in Fig. 21, Fig. 24, and steps S609, S613, S615 in Fig. 26), and

for automatically prohibiting selecting an inoperable mode of operation of the plurality of modes

of operation through the operation panel based on the result of the comparison (column 14, lines

6 through 18, and steps S616 and S617 in Fig. 26, column 19, lines 14 through 21).

Regarding **claim 5**, Yoshida discloses the image processing device discussed in claim 4,

and further teaches of the decision controller determines a length of a frame of the image data in a

predetermined direction (column 10, lines 3 through 7, and Fig. 14, which shows the page length

in the main scanning direction, and the length in the sub-scanning direction).

Regarding **claim 6**, Yoshida discloses the image processing device discussed in claim 4,

and further teaches of the decision controller determines a frame size of the image data (column

10, lines 3 through 7, and Fig. 14, which shows the page length in the main scanning direction,

and the length in the sub-scanning direction).

Regarding *claim 13*, Yoshida discloses an image forming apparatus operable in a plurality

of print modes ("Nin1" operations, such as 2in1 or 4in1, etc., shown in Fig. 24), comprising a

memory (multiport image memory 304 within memory 30, see Fig. 5) for storing image data of a

plurality of frames (column 6, lines 47 through 51, wherein two frames or pages are stored, and

column 7, lines 25 through 28), a printer for reading the image data stored in the memory for each

frame and for printing (print processing part PRT 40, column 4, line 63 through column 5, line

10), a controller (CPU 3, column 5, lines 27 through 32) for determining a state of the image data

stored in the memory (column 6, lines 58 through column 7, line 2, and see Fig. 23, column 15,

lines 37 through 46), an operation panel (shown in Fig. 7) for selecting any of the plurality of print

modes (column 8, line 62 through column 9, line 20), and a controller (CPU3, column 5, lines 27

through 32) for comparing the state of at least two frames (column 14, lines 19 through 46, and

particularly column 16, lines 17 through 55, wherein the character size of one document is

compared to predetermined pixels, and then repeated for a second document, thus comparing at

least two frames), as determined by the state decision controller (steps S106 in Fig. 21, Fig. 24,

and steps S609, S613, S615 in Fig. 26), and for automatically prohibiting selecting an inoperable

print mode of the plurality of print modes through the operation panel based on the result of the

comparison (column 14, lines 6 through 18, and steps S616 and S617 in Fig. 26, column 19, lines

14 through 21).

Regarding *claim 27*, Yoshida discloses the image processing device discussed in claim 4

above, and further teaches of a display for displaying an operating state of the image processing

device (LCD panel, column 9, lines 1 through 15), and a controller (CPU1), responsive to the

selection prohibiting controller, for displaying on the display an operable mode of operation of the

plurality of modes operation (column 5, lines 20 through 22, and column 8, line 62 through

column 9, line 20).

Regarding *claim 28*, Yoshida discloses an image processing device operable in a plurality

of modes of operation ("Nin1" operations, such as 2in1 or 4in1, etc., shown in Fig. 24),

comprising a memory (multiport image memory 304 within memory 30, see Fig. 5) for storing

image data of a plurality of frames (column 6, lines 47 through 51, wherein two frames or pages

are stored, and column 7, lines 25 through 28), a controller (CPU 3, column 5, lines 27 through

32) for determining a state of the image data for each frame (column 6, lines 58 through column

7, line 2, and see Fig. 23, column 15, lines 37 through 46), a controller (CPU3, column 5, lines 27

through 32) for comparing the state of at least two frames (column 14, lines 19 through 46, and

particularly column 16, lines 17 through 55, wherein the character size of one document is

compared to predetermined pixels, and then repeated for a second document, thus comparing at

least two frames), as determined by the state decision controller (steps S106 in Fig. 21, Fig. 24,

and steps S609, S613, S615 in Fig. 26), and for automatically prohibiting selecting an inoperable

mode of operation of the plurality of modes of operation through the operation panel based on the

result of the comparison (column 14, lines 6 through 18, and steps S616 and S617 in Fig. 26,

column 19, lines 14 through 21), and an operation panel (shown in Fig. 7), responsive to the

selection prohibiting controller, for selecting any of the plurality of modes of operation, with the

operation panel automatically prohibiting selecting the thus determined inoperable mode of

operation (column 8, line 62 through column 9, line 20, and column 14, lines 13 through 18).

Regarding *claim 29*, Yoshida discloses the image processing device discussed in claim 28

above, and further teaches of the state of the image data determined by the state decision

controller for each frame thereof is a frame size (column 10, lines 3 through 7, and Fig. 14, which

shows the page length in the main scanning direction, and the length in the sub-scanning

direction).

Regarding *claim 30*, Yoshida discloses the image processing device discussed in claim 29

above, and further teaches of the plurality of modes of operation include at least one of economy

print mode (economized Nin1 function, column 9, lines 46 through 57), two-side print mode, and

staple print mode.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

8.   **Claim 23** is rejected under 35 U.S.C. 103(a) as being unpatentable over Collard *et al.*

(U.S. Patent Number 5,825,988, cited in the Office action dated 8/3/99) in view of Yoshida *et al.*

(U.S. Patent Number 5,930,006).

Regarding *claim 23*, Collard discloses an image forming apparatus operable in a plurality

of print modes (see Figs. 6A and 6B, digital, 2-sided, and 1-sided modes), comprising a memory

(central storage means 15, or memory disc 23) for storing a plurality of print jobs (column 5, lines

9 through 61), each print job containing image data of at least two frames (column 5, lines 20

through 29), a selector for selecting one of the plurality of print jobs stored in the memory

(column 7, lines 18 through 27), a controller (control module 18) for determining a state of the

image data contained in the print job selected by the print-job selector (column 7, lines 28 through

37), a printer (printing unit 3) for printing the image data contained in the print job selected by the

print-job selector (column 4, lines 15 through 60), and an operation panel (panel 19) for selecting

any of the plurality of print modes (column 6, lines 10 through 65), and a controller (control unit

18) for selecting a print mode of the plurality of print modes through the operation panel based on

the thus determined state of the image data contained in the print job selected by the print-job selector (column 4, line 61 through column 5, line 8, and column 7, lines 33 through 63). However, Collard fails to teach of the controller for comparing the state of at least two frames, as determined by the state decision controller, and for automatically prohibiting selecting an inoperable print mode based on the result of the comparison.

Yoshida discloses an image forming apparatus operable in a plurality of print modes ("Nin1" operations, such as 2in1 or 4in1, etc., shown in Fig. 24), comprising a memory (multiport image memory 304 within memory 30, see Fig. 5) for storing image data of at least two frames (column 6, lines 47 through 51, wherein two frames or pages are stored, and column 7, lines 25 through 28), a controller (CPU 3, column 5, lines 27 through 32) for determining a state of the image data stored in the memory (column 6, lines 58 through column 7, line 2, and see Fig. 23, column 15, lines 37 through 46), a printer for printing the image data stored in the memory for each frame and for printing (print processing part PRT 40, column 4, line 63 through column 5, line 10), an operation panel (shown in Fig. 7) for selecting any of the plurality of print modes (column 8, line 62 through column 9, line 20), and a controller (CPU3, column 5, lines 27 through 32) for comparing the state of at least two frames (column 14, lines 19 through 46, and particularly column 16, lines 17 through 55, wherein the character size of one document is compared to predetermined pixels, and then repeated for a second document, thus comparing at least two frames), as determined by the state decision controller (steps S106 in Fig. 21, Fig. 24, and steps S609, S613, S615 in Fig. 26), and for automatically prohibiting selecting an inoperable

Application/Control Number: 08/941,459

Art Unit: 2722

print mode of the plurality of print modes through the operation panel based on the result of the comparison (column 14, lines 6 through 18, and steps S616 and S617 in Fig. 26, column 19, lines 14 through 21). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Yoshida's teachings within Collard's system. Collard's system could easily be modified to include Yoshida's teachings since both systems share cumulative features.

Allowable Subject Matter

9. **Claims 14 through 16, and 24 through 26** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles, can be reached on (703) 305-4712. The fax phone number for this Group is (703) 306-5406.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800/4700.

Joseph R. Pokrzywa

March 2, 2000

EDWARD L. COLES/
SUPERVISORY PATENT EXAMINER
GROUP 2700